

REMARKS

In view of the above-noted amendments and remarks to follow, reconsideration and withdrawal of the objections and rejections of the application, and early allowance of the claims are earnestly solicited.

Claims 1-25 and new claims 26-44 are pending in the application. A check in the amount of \$430 in payment for the filing of the RCE and a 1-month extension of time has been included with this paper. A separate check has been included in the amount of \$294 for the addition of 4 new independent claims and 14 dependent claims. Any additional fees occasioned by this paper or any overpayment in fees, may be charged or credited to **Deposit Account No. 50-0320**.

Initially, the Applicants would like to thank the Examiner for indicating in the most recent office action that claims 16, 19, 20 and 23-25 are allowable.

Additionally, the Applicants would like to thank the Examiner for conducting the post-final office action interview with the Applicant's attorneys.

In the Final Office Action dated February 25, 2003, the Examiner noted that the proposed drawing amendments were acceptable and that formal drawings are required with this paper. Accordingly, formal drawings as found acceptable by the Examiner have been submitted herewith.

The Final Office Action rejected claims 15, 17-18, and 21-22 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,121,603 to Hang et al. (the '603 patent). Relying on the definition of "body" from Merriam Webster's Collegiate Dictionary, 10th ed. the Office Action states that a "body" is a mass of matter distinct from other masses, e.g. a body of water. Further, the examiner states that the sample object (52) as shown in Fig. 6A is a body, distinct from the

body of air around it. Using this definition, the Examiner states that the device described in the '603 patent is "at least inserted into a body of air if not the sample object itself."

Applicants attorneys respectfully disagree with this construction of the claim elements and the overly broad definition of the term "body." Initially, it appears that the Office Action reads the term "insertable" out of the claim. "Insertable into a body" clearly describes an object resident in a mass of matter, as all objects are at all times whether on earth or in space, that can be inserted into the second body or mass of matter. The interpretation of the Office Action neglects to take into account the obvious fact that all objects are at all times immersed in a "body" of one form or another. Further, the interpretation fails to read in the "insertable" term that clearly denotes the presence of a second body into which the object is to be inserted. It would be apparent to one of ordinary skill in the art that an object, such as a confocal microscope, cannot be inserted into a "body," such as the air as contemplated by the Office Action, in which it is already and at all times immersed. To insert into a body clearly contemplates residence in one body and "insertion" into a second. Still further, as is clearly shown in Fig. 6A of the '603 patent, the device is not inserted into the sample 52, but rather the lens 80 is some distance from the surface of the sample 52 whose surface is represented by Ob_o. Accordingly, it is respectfully submitted that the Final Office action's interpretation of the phrase "insertable into a body" is overly broad and reads "insertable" out of the claim element. Therefore, it is respectfully submitted that claims 15, 17-18, and 21-22 patentably distinguish over the cited reference.

The Final Office Action also rejected claims 1-3, 5-6, 8-9 and 14 under 35 U.S.C. § 103(a) as unpatentable over the '603 patent in view of U.S. Patent No. 6,370,422 to Richards-Kortum et al. (the '422 patent). The Office Action reiterates the reasoning above with regard to

the term “body,” and the teachings of the ‘603 patent. Further, the Office Action states that the ‘422 patent teaches the use of a confocal microscope probe in place of an endoscope within the body. However, upon review of the cited sections of the ‘422 patent it is respectfully submitted that there is no reference to a remote probe insertable into the body. Rather, the cited section refers to imaging through the surface of tissue to planes that are parallel to surface of the tissue through the use of a suction device that draws the layers of tissue into the device. Accordingly, it is respectfully submitted that the present invention is not taught or suggested by the cited references whether taken individually or in combination. Accordingly it is respectfully submitted that claims 1-3, 5-6, 8-9 and 14 patentably distinguish over the cited references and are allowable.

Finally the Final Office Action rejects claims 4, 7, 11, and 12 under 35 U.S.C. § 103(a) as unpatentable over the ‘603 patent in view of the ‘422 patent, and in further view of U.S. Patent No. 5,323,009 to Harris. As all of these claims depend from the independent claims discussed above, it is respectfully submitted that claims 4, 7, 11, and 12 patentably distinguish over the cited references for at least the reasons listed herein and are allowable.

By this amendment new claims 26-44 have been added to this application. In these claims, the term “body” is replaced with the term “subject.” The term “subject” is supported by the specification on page 1 where “a region of interest” is described as “tissue ex-vivo, or in-vivo.” The region of interest is understood by those skilled in the art to be a portion of the “subject.” Further, it known to those skilled in the art that every optical device will have a subject. This is true regardless of whether the optical device is a telescope looking at the stars or a confocal microscope imaging tissue samples. Accordingly, it is respectfully submitted that new claims 26-44 are fully supported by the specification and the knowledge of those skilled in

the art. Further it is submitted that new claims 26-44 patentably distinguish over the prior art of record and are allowable.

Additional U.S. Patents have been made of record, but not applied. The implicit finding that these documents, whether considered alone or in combination with others, do not render the claims of the present application unpatentable, is appreciated.

REQUEST FOR INTERVIEW

If the Examiner is of the view that any issue remains as an impediment to allowance, prior to the issuance of any paper other than a Notice of Allowance, an interview with the Examiner is respectfully requested, and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time therefor.

In view of the amendments and remarks herewith, the application is in condition for allowance. Favorable reconsideration of the application, and withdrawal of the objections and rejections and prompt issuance of a Notice of Allowance is earnestly solicited.

Respectfully submitted,
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